

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Shizuo Akira et al.

Group Art Unit: 1632

Serial No.: 10/088,567

Examiner: Anoop Kumar Singh

Filed: March 19, 2002

Confirmation No. 3078

For: Transgenic Toll-Like Receptor 9 (TLR9) Mice

REQUEST FOR RECONSIDERATION OF USPTO DECISION

REGARDING CORRECTION OF PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is to request reconsideration of the USPTO decision of February 10, 2009, which held in abeyance the previous request for correction of Patent Term Adjustment Under Rule 705(b), submitted on October 1, 2008. The reason for holding the decision in abeyance was that the patent had not issued, and the issue date would be required to make an accurate determination of the patent term adjustment, if any, to which the Patentee would be entitled. The patent for the application issued on March 24, 2009, as U.S. Patent 7,507,872. Therefore, Patentees respectfully request reconsideration of the previous USPTO decision.

For the convenience of the USPTO, the facts as set forth in the October 1, 2008 request are set forth again below, with updated information in view of the USPTO decision of February 10, 2009. The \$200 fee required by Rule 18(e) was authorized in the original request of October 1, 2008, and according to the USPTO Decision of February 10, 2009, the fee does not need to be paid again for this request for reconsideration. This patent is not subject to a terminal disclaimer.

Pursuant to Rule 703(b), the Office is to grant a patent term adjustment for the number of days that exceeds 36 months from the filing date of the application to the issue date of the application, excluding

- 1) the period following the filing of an RCE,
- 2) (i) following the declaration of an interference,
 - (ii) the period of suspension of prosecution due to an interference,
- 3) the period the application is under seal, and
- 4) the period of appeal.

Where a notice of appeal is filed, the period of adjustment under this paragraph "restarts" upon the mailing of a notice of allowance (see Rule 703(b)(4)). The calculation of Patent Term Adjustment follows.

Calculation of Patent Term Adjustment

Under Rule 703(a)

Applicants agree with the USPTO determination that the PTO incurred 1134 days delay under 703(a) for the period beginning 14 months from filing (*i.e.*, May 19, 2003) until the mailing of a Restriction Requirement on June 26, 2006. The USPTO also incurred 35 days of delay under 703(a) for the period beginning 4 months from payment of the issue fee (*i.e.*, Feb. 17, 2009) until the issue date on March 24, 2009.

Thus, the total period of USPTO delay under Rule 703(a) is 1169 days (1134 days plus 35 days).

Under Rule 703(b)

The application was filed on March 19, 2002, and the period exceeding 36 months begins March 19, 2005. A Notice of Appeal was filed on March 12, 2008. The period from March 19, 2005 until March 12, 2008 is 1089 days.

A Notice of Allowance was mailed on May 8, 2008, restarting the period under Rule 703(b). An RCE was filed on June 24, 2008. The period from May 8, 2008 until June 24, 2008 is 47 days.

Thus, the total period of USPTO delay under Rule 703(b) is 1136 days (1089 days plus 47 days).¹

Reduction Under Rule 704

The USPTO has found 161 days of Applicant delay (95 + 53 + 13).

Period of Patent Term Adjustment

The period for patent term adjustment should be the sum of non-overlapping days under Rules 703(a) and 703(b) minus the days of Applicant delay.

In the “Patent Term Adjustment” tab in the official image file wrapper (Private-PAIR) for this application, the USPTO appears to include a value of 59 days for the USPTO’s delay under Rule 703(b) (see entry dated March 4, 2009 under the description “PTA 36 months”). The USPTO value of 59 days appears to be a result of the USPTO’s interpretation of the “overlap” between Rules 703(a) and 703(b). However, the USPTO’s interpretation is incorrect and inconsistent with the court’s decision in *Wyeth v. Dudas* (D.D.C. 2008) which held that the PTO’s interpretation of overlap between Rules 703(a) and 703(b) cannot be reconciled with the plain text of the statute.

The correct calculation of patent term adjustment should include a larger value for Rule 703(b). Applicants believe that in this case the delays under Rules 703(a) and 703(b) are only partially overlapping. Specifically, the overlap in delays under Rules 703(a) and 703(b) occurs from March 19, 2005 until June 26, 2006, a period of 464 days.

Therefore, Applicants are entitled to the sum of 703(a) delay (1169 days) plus 703(b) delay (1136 days) minus overlap (464 days) and minus the period of Applicant delay (161 days), for a total of 1680 days of Patent Term Adjustment.

Summary of Requested Correction to PTA

The patent term adjustment of 1067 days according to the face of U.S. Patent No. 7,507,872, is incorrect because it miscalculates the overlap between Rule 703(a) and Rule 703(b), as calculated above according to the plain language of the statute.

¹ The PTO calculation appears to also include 57 days for the period from March 12, 2008 (Notice of Appeal) until May 8, 2008 (Notice of Allowance), although this period appears to be excluded by Rule 703(b)(4).

Applicants request that the patent term adjustment be corrected to add a total of 1680 rather than 1067 days of term.

AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 14119.105010. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 14119.105010. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 14119.105010.

Respectfully submitted,
King & Spalding, LLP

Dated: April 14, 2009

By: /michael willis/
Kenneth H. Sonnenfeld / Michael A. Willis
Reg. No. 33,285 / Reg. No. 53,913

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Paper No. _____

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NEW YORK NY 10036-4003

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FEB 10 2009

OFFICE OF PETITIONS

In re Application of	:	
Akira et al.	:	DECISION ON APPLICATION
Application No. 10/088,567	:	FOR
Filed: March 19, 2002	:	PATENT TERM ADJUSTMENT
Attorney Docket No.	:	
14119.1050100	:	

This is a decision on the "PETITION FOR CORRECTION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed on October 1, 2008. Applicants requests that the Patent Term Adjustment for the above-identified patent be increased by 672 days from 1039 days to 1711 days on the basis that the Office will take in excess of three years to issue the patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in *abeyance* until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentee is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment

of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Nonetheless, for the reasons stated herein, the Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is NINE HUNDRED SEVENTY-THREE (973) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 22, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is one thousand thirty-nine (1039) days. This was calculated based on an Office delay of 1134 days reduced by 95 days of applicant delay.

A review of the record reveals basis for entry of additional periods of reduction pursuant to 37 CFR 1.704(b) and 1.704(c)(10). 37 CFR 1.704(b) states that:

an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

After final Office action, the reply considered in calculating applicant delay pursuant to 37 CFR 1.704(b), is the one in compliance with 1.113(c). In this instance, an Office action was mailed on October 19, 2007. Applicant responded with the filing of an amendment on January 9, 2008 and a notice of appeal on March 12, 2008. As the amendment filed January 9, 2008, was

not in compliance with § 1.113(c), the period for reply to the final rejection mailed October 19, 2007, continued to run. See Advisory Action mailed February 8, 2008. The proper reply, a Notice of Appeal, was not received in the Office until March 12, 2008, which is outside of the three-month period under 37 CFR 1.704(b). Accordingly, a period of reduction for applicant delay of 53 days is being entered, counting the number of days beginning on January 20, 2008, the day after the date that is three months after the date of mailing of the final rejection, and ending on March 12, 2008, the date the Notice of Appeal was filed.

Additionally it is noted that on May 8, 2008, a notice of allowance was mailed. Thereafter, on May 23, 2008, a supplemental Information Disclosure Statement (IDS) was filed. On June 4, 2008, an Office communication in response to the supplemental IDS was mailed.

37 CFR 1.704(c)(10) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of the number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or four months.

37 CFR 1.704(d) further states that:

a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that

this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

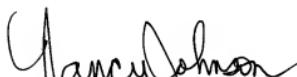
The IDS filed on May 23, 2008 was filed after the mailing of a notice of allowance and did not include the statement specified at 37 CFR 1.704(d). Accordingly, a period of reduction for applicant delay of 13 days is being entered, counting the number of days beginning on May 23, 2008, the date the IDS was filed, and ending on June 4, 2008, the date the Office communication in response was mailed.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is nine hundred **seventy-three** (973) days (1134 days of Office delay reduced by 161 (95+13+53) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Encl: Copy of adjusted PAIR calculation

PALM INTRANET

Day : Monday
 Date: 2/9/2009
 Time: 09:51:45

PTA Calculations for Application: 10/088567

Application Filing Date:	03/19/2002	PTO Delay (PTO):	1134
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	95
Post-Issue Petitions:	0	Total PTA (days):	973
PTO Delay Adjustment:	-66		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
151	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		13	
150	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		53	
129	08/22/2008	MAIL NOTICE OF ALLOWANCE			
128	08/18/2008	ISSUE REVISION COMPLETED			
127	08/18/2008	DOCUMENT VERIFICATION			
126	08/18/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
125	08/18/2008	EXAMINER'S AMENDMENT COMMUNICATION			
124	08/18/2008	NOTICE OF ALLOWABILITY			
123	07/09/2008	MISCELLANEOUS INCOMING LETTER			
114	07/09/2008	EMAIL NOTIFICATION			
113	07/09/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
112	06/24/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
111	07/01/2008	DATE FORWARDED TO EXAMINER			
110	06/24/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
109	07/01/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
108	06/24/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
107	03/12/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
106	06/04/2008	EMAIL NOTIFICATION			
105	06/04/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
104	06/02/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
		INFORMATION DISCLOSURE STATEMENT			

103	05/23/2008	CONSIDERED		
102	05/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
101	05/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
99	05/16/2008	SEQUENCE FORWARDED TO PUBS ON TAPE		
98	05/09/2008	EXPORT TO INITIAL DATA CAPTURE		
97	05/09/2008	ELECTRONIC REVIEW		
96	05/08/2008	EMAIL NOTIFICATION		
95	05/08/2008	EMAIL NOTIFICATION		
94	05/08/2008	MAIL EXAMINER'S AMENDMENT		
93	05/08/2008	MAIL NOTICE OF ALLOWANCE		
87	04/25/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED		
86	04/25/2008	CASE DOCKETED TO EXAMINER IN GAU		
85	04/24/2008	ISSUE REVISION COMPLETED		
84	03/12/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
83	04/14/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)		
82	04/22/2008	EXAMINER'S AMENDMENT COMMUNICATION		
81	04/22/2008	NOTICE OF ALLOWABILITY		
71	03/12/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
70	03/29/2008	DATE FORWARDED TO EXAMINER		
69	03/12/2008	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL		
68	03/12/2008	NOTICE OF APPEAL FILED		
67	03/12/2008	REQUEST FOR EXTENSION OF TIME - GRANTED		
66	03/12/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
64	03/10/2008	EMAIL NOTIFICATION		
63	03/10/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)		
62	02/26/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)		
60	02/09/2008	EMAIL NOTIFICATION		
59	02/08/2008	MAIL ADVISORY ACTION (PTOL - 303)		
58	02/04/2008	ADVISORY ACTION (PTOL-303)		

57	01/09/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
56	01/09/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT	0	54
55	01/24/2008	DATE FORWARDED TO EXAMINER		
54	01/09/2008	AMENDMENT AFTER FINAL REJECTION		
53	01/09/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
52	12/19/2007	EMAIL NOTIFICATION		
51	12/19/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)		
50	12/14/2007	CORRESPONDENCE ADDRESS CHANGE		
49	10/19/2007	MAIL FINAL REJECTION (PTOL - 326)		
48	10/15/2007	FINAL REJECTION		
46	03/30/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
45	07/31/2007	DATE FORWARDED TO EXAMINER		
44	07/20/2007	RESPONSE AFTER NON-FINAL ACTION	17	41
43	07/17/2007	MAIL NOTICE OF INFORMAL OR NON- RESPONSIVE AMENDMENT		
42	07/16/2007	DATE FORWARDED TO EXAMINER		
41.1	07/03/2007	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION		
41	07/03/2007	RESPONSE AFTER NON-FINAL ACTION		
40.7	03/30/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	78	35
40	03/30/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
39	04/03/2007	MAIL NON-FINAL REJECTION		
38	03/31/2007	NON-FINAL REJECTION		
37	01/11/2006	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)		
36	01/23/2007	DATE FORWARDED TO EXAMINER		
35	01/11/2007	RESPONSE AFTER NON-FINAL ACTION		
34	10/12/2006	MAIL NON-FINAL REJECTION		
33	10/02/2006	NON-FINAL REJECTION		
32	09/14/2006	CASE DOCKETED TO EXAMINER IN GAU		
31	07/26/2006	DATE FORWARDED TO EXAMINER		
30	07/18/2006	RESPONSE TO ELECTION / RESTRICTION FILED		
29	06/26/2006	MAIL RESTRICTION REQUIREMENT	1134	-1

28	06/23/2006	REQUIREMENT FOR RESTRICTION / ELECTION		
27	05/12/2006	CASE DOCKETED TO EXAMINER IN GAU		
26	03/19/2002	371 COMPLETION DATE		
25	03/22/2006	APPLICATION RETURN FROM OIPE		
24	03/23/2006	NOTICE OF DO/EO ACCEPTANCE MAILED		
23	03/14/2006	ADDITIONAL APPLICATION FILING FEES		
22	03/14/2006	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN		
21	03/14/2006	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT		
20	03/20/2006	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE		
19	01/09/2006	SEQUENCE DISCLOSURE PROBLEMS		
18	03/19/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN		
17	03/19/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT		
16	07/08/2002	PRE-EXAM OFFICE ACTION WITHDRAWN		
15	01/07/2006	APPLICATION RETURN TO OIPE		
14	12/20/2005	CASE DOCKETED TO EXAMINER IN GAU		
13	12/14/2005	APPLICATION RETURN FROM OIPE		
12	01/12/2004	APPLICATION RETURN TO OIPE		
11	08/15/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE		
10.7	07/22/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
10	07/22/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
9	03/19/2002	PRELIMINARY AMENDMENT		
8.7	03/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
8	03/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
7	08/05/2002	CASE DOCKETED TO EXAMINER IN GAU		
6	07/26/2002	IFW SCAN & PACR AUTO SECURITY REVIEW		
5	07/22/2002	APPLICATION DISPATCHED FROM OIPE		
4	07/08/2002	NOTICE OF DO/EO ACCEPTANCE MAILED		

3	03/19/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT		
2	04/09/2002	ERROR(S) IN CRF CORRECTED BY STIC		
1	03/19/2002	INITIAL EXAM TEAM NN		

Search Another: Application#

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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